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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,714	01/08/2002	Daniel R. Ahles	1DATA.041A	5233
20995 7590 02/14/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER OYEBISI, OJO O	
			ART UNIT 3692	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/14/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/14/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/041,714

Applicant(s)

AHLES ET AL.

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/18/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election without traverse of Group I (claims 1-29, and 38) in the reply filed on 12/01/06 is acknowledged.

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claim 7** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The applicant recites the phrase "a first instruction module" and "a second instruction module" which appear to be directed to computer program.

Software, programming, instructions or code not claimed as encoded on computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

Claim 7 is therefore rejected where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer.

Examiner suggests that the applicant incorporate into Claim 7 language that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4-5, 7-9, 11-29 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Carney et al (Carney, hereinafter, US PAT: 5,890,141).

Re claim 1. Carney discloses a method of receiving a check identifier entered by a user, the method comprising: requesting a user to review an original check identifier in

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MICR format (see abstract), the original check identifier including a plurality of fields separated by separator symbols, the plurality of fields including a routing number field, an account number field and a check number field (see fig.1); instructing the user to replace the separator symbols of the original check identifier in MICR format with replacement symbols, thereby obtaining a substitute check identifier with replacement symbols; requesting the user to enter the substitute check identifier; and identifying the routing number field, the account number field and the check number field within the entered substitute check identifier (see fig.1 elements 30, 40 and 50, also see fig.4 elements 510, 530, see col.4 lines 32-56).

Re claim 2. Carney further discloses the method wherein the users uses a computer keyboard to enter the replacement symbols keyboard (Carney discloses inputting MICR data, see fig.4 elements 510 and 530 which is inherently done by the use of a computer keyboard).

Re claim 4. Carney discloses a method comprising instructing a user to replace the separator symbols within an original MICR format check identifier with replacement symbols, thereby obtaining a substitute check identifier (i.e., At block 520 and 530, the MICR data is inputted and stored at (J) index value location in the system. The system at; block 540 interprets the payee name and other appropriate check data, including the algorithm number and check digit if printed on the face or MICR line of the check, then applies the appropriate algorithm to the captured MICR line and image to generate a check digit value CD (J). At test 550, if the algorithm number and/or check digit are not found

on the check, the system queries as to the existence of a paid issuance file, previously transferred from the drawee bank, see col.7 lines 18-40).

Re claim 5. Carney further discloses the method further comprising instructing the user to enter the substitute check identifier with a computer keyboard (Carney discloses inputting MICR data, see fig.4 elements 510 and 530 which is inherently done by the use of a computer keyboard).

Re claim 7. Carney further discloses a check entry system comprising: a first instruction module configured to instruct a user to replace the separator symbols within an original MICR-format check identifier with replacement symbols, thereby obtaining a substitute check identifier; and a second instruction module configured to instruct the user to enter the substitute check identifier into a computer system (i.e., input check (j), input MICR(J), see fig.4 elements 510 and 530, also fig.7 lines 18-25) or a telephone system.

Re claim 8. Carney further discloses a method comprising instructing a user to replace the separator symbols within an original MICR format check identifier with replacement symbols, thereby obtaining a substitute check identifier (i.e., At block 520 and 530, the MICR data is inputted and stored at (J) index value location in the system. The system at; block 540 interprets the payee name and other appropriate check data, including the algorithm number and check digit if printed on the face or MICR line of the check, then applies the appropriate algorithm to the captured MICR line and image to generate a check digit value CD (J). At test 550, if the algorithm number and/or check digit are not found

on the check, the system queries as to the existence of a paid issuance file, previously transferred from the drawee bank, see col.7 lines 18-40).

Re claim 9. Carney further discloses the method further comprising instructing the user to enter the substitute check identifier with a computer keyboard (Carney discloses inputting MICR data, see fig.4 elements 510 and 530 which is inherently done by the use of a computer keyboard).

Re claims 11-15. Carney further discloses a method of receiving a check identifier during a check transaction, the method comprising: receiving a substitute check identifier (i.e., expected check digit received from the issuer, see col.4 lines 25-30) the substitute check identifier comprising a routing number, an account number and a check number, the substitute check identifier further including at least one replacement symbol wherein the replacement symbol substitutes for at least one separator symbols within a MICR line (see fig.1 elements 30, 40, 50); and processing the substitute check identifier to identify at least one of the routing number, the account number and the check number (i.e., At block 520 and 530, the MICR data is inputted and stored at (J) index value location in the system. The system at; block 540 interprets the payee name and other appropriate check data, including the algorithm number and check digit if printed on the face or MICR line of the check, then applies the appropriate algorithm to the captured MICR line and image to generate a check digit value CD (J). At test 550, if the algorithm number and/or check digit are not found on the check, the system queries as to the existence of a paid issuance file, previously transferred from the drawee bank, see col.7 lines 18-40).

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Re claims 16, 17, 18. Carney further discloses the method wherein the act of processing the substitute check identifier identifies the routing number by searching for a field comprising at least nine digits (i.e., At block 520 and 530, the MICR data is inputted and stored at (J) index value location in the system. The system at; block 540 interprets the payee name and other appropriate check data, including the algorithm number and check digit if printed on the face or MICR line of the check, then applies the appropriate algorithm to the captured MICR line and image to generate a check digit value CD (J). At test 550, if the algorithm number and/or check digit are not found on the check, the system queries as to the existence of a paid issuance file, previously transferred from the drawee bank, see col.7 lines 18-40).

Re claim 19. Carney further discloses the method wherein the act of processing the substitute check identifier identifies the account number by first identifying the routing Field (see fig.1 element 30).

Re claim 20. Carney further discloses the method wherein the act of processing the substitute check identifier identifies the check number by comparing the fields in the substitute check identifier to a separately entered check number (see col.4 lines 25-31).

Re claim 21. Carney further discloses the method wherein the replacement symbol exists between the account number and the routing number (see fig.1 element 30, 40, and 50).

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Re claim 22. Carney further discloses the method wherein the replacement symbol exists between the account number and the check number (see fig.1 element 30, 40, and 50).

Re claim 23. Carney further discloses the method wherein the replacement symbol exists at the beginning of the check identifier (see fig.1 element 30, 40, and 50).

Re claims 24, 25, and 26. Carney further discloses a method of receiving a check identifier during a check transaction, the method comprising: receiving from a user, a substitute check identifier (i.e., expected check digit received from the issuer, see col.4 lines 25-30), wherein the substitute check identifier has at least one replacement symbol that is used in lieu of a separator symbol within an original check identifier (see fig.1 elements 30, 40, 50); and parsing the received substitute check identifier to distinguish at least one of the routing number field, the account number field and the check number field (i.e., At block 520 and 530, the MICR data is inputted and stored at (J) index value location in the system. The system at; block 540 interprets the payee name and other appropriate check data, including the algorithm number and check digit if printed on the face or MICR line of the check, then applies the appropriate algorithm to the captured MICR line and image to generate a check digit value CD (J). At test 550, if the algorithm number and/or check digit are not found on the check, the system queries as to the existence of a paid issuance file, previously transferred from the drawee bank, see col.7 lines 18-40).

Re claim 27. Carney further discloses the method, further comprising: verifying that the entered substitute check identifier includes at least one replacement symbol, and if the

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substitute check identifier does not include at least one replacement symbol, instructing the user to enter a substitute check identifier with at least one replacement symbol (i.e., At block 520 and 530, the MICR data is inputted and stored at (J) index value location in the system. The system at; block 540 interprets the payee name and other appropriate check data, including the algorithm number and check digit if printed on the face or MICR line of the check, then applies the appropriate algorithm to the captured MICR line and image to generate a check digit value CD (J). At test 550, if the algorithm number and/or check digit are not found on the check, the system queries as to the existence of a paid issuance file, previously transferred from the drawee bank, see col.7 lines 18-40)

Re claim 28. Carney further discloses the method, wherein the act of parsing comprises identifying a first nine-digit distinguished field within the substitute check identifier as the routing number (see fig.1 elements 30, 40, and 50).

Re claim 29. Carney further discloses the method, wherein the act of parsing comprises identifying a distinguished field that matches the user-entered check number as the check number field, and identifying the routing number field (i.e., At block 520 and 530, the MICR data is inputted and stored at (J) index value location in the system. The system at; block 540 interprets the payee name and other appropriate check data, including the algorithm number and check digit if printed on the face or MICR line of the check, then applies the appropriate algorithm to the captured MICR line and image to generate a check digit value CD (J). At test 550, if the algorithm number and/or check

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digit are not found on the check, the system queries as to the existence of a paid issuance file, previously transferred from the drawee bank, see col.7 lines 18-40).

Re claim 38. Carney further discloses a system for receiving a check identifier during a check transaction, the system comprising a means for receiving a substitute check identifier (see col.4 lines 18-30), wherein the substitute check identifier comprises at least one replacement symbol that replaces at least one separator symbol within an original MICR format check identifier with at least one generic symbol (see fig.1 elements 30, 40, 50).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 3, 6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carney.

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Re claims 3, 6, 10. Carney does not explicitly disclose the method wherein the users use a telephone keypad to enter the replacement symbols. However, as per these features, the Examiner asserts that it is well known in the art at the time of the invention for a purchaser or buyer performing a remote purchase to either use a touch tone phone to input their check number or the MICR line. The user may also opt to speak these information to an operator or a voice recognition system. Thus it would have been obvious to one of ordinary skill in the art to incorporate such a feature in the system of Carney in order to allow or facilitate remote purchasing by a customer or user from a remote merchant.

Conclusion

A prior art of record, Page (US PAT: 6,464,134), cited but not relied upon is found to be pertinent to the claimed subject matter in following ways: "A system and method for verifying the authenticity of a bank check and authorizing payment of the bank check at any of a plurality of banks or check cashing agencies, wherein a payor or issuer of the check integrates account data normally pre-printed on the face of the check with individualized payee data, at least including payee identification and a value of the check, so as to define a first set of data, which is communicated to a processing center for temporary storage and eventual comparison. Upon presentation of the check for deposit or cashing, the bank or check cashing agency will establish a second set of data based on the pre-printed account data and the individualized payee data that appears on the face of the check presented. The second set of data

is communicated to the processing center where the first and second sets of data are compared to assure that at least the payee identification and the value of the check are identical to the same information printed on the check at the issuing site. Upon such a positive comparison, a verification signal is communicated to the cashing terminal or site so as to authorize payment of the check."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD E. CHILCOT can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


RICHARD E. CHILCOT, JR.
SUPERVISORY PATENT EXAMINER